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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/784,707	02/15/2001	Angelo Bastioli	13929/TBA	3139

38834 7590 07/26/2004

WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP  
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WASHINGTON, DC 20036

EXAMINER
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CHANG, VICTOR S

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 07/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/784,707	BASTIOLI ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Victor S Chang	1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 June 2004 and 08 April 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4, 7, 8 and 10-45 is/are pending in the application.
- 4a) Of the above claim(s) 33-38 and 41-45 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 7, 8, 10-32, 39 and 40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>6/8/2004</u> .  | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

1. The Examiner has carefully considered Applicants' Information Disclosure Statement filed on 6/8/2004, and the amendments and remarks filed on 4/8/2004. Applicants' amendments to claims 1 and 7, cancellation of claims 5 and 6 have been entered, as previously indicated in the Advisory action mailed on 4/20/2004.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Rejections not maintained are withdrawn.

### ***Claim Objections***

4. Claim 1 is objected to because of the following informalities:

The Examiner suggests the amended claim 1 use the same Markush language format as the cancelled claim 5.

Appropriate correction is required.

### ***Response to Amendment***

5. Claims 1-4, 7, 8, 10-32, 39, 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Altieri (US 5153037), substantially for the reasons set forth in section 4 of Office action mailed 10/15/2003, together with the following additional observations.

It is noted that claim 1 has been amended to incorporate the elements from cancelled claims 5 and 6. Claim 1 now recites, *inter alia*, "said destructured or

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complexed starch is a natural starch from one of potato, wheat, maize and tapioca starch".

With respect to Applicants' argument that "Altieri teaches away from the claimed invention. There is no suggestion or teaching provided by Altieri which would have motivated one of ordinary skill art to employ a starch having an amylose content less than the 45% by weight required by Altieri" (Remarks, page 14, 4<sup>th</sup> paragraph), the Examiner repeats (see Advisory mailed 10/15/2003) that while Altieri teaches a biodegradable shaped product comprising an expanded modified flour product preferably having at least 40% by weight amylose content (Abstract), nowhere does Altieri expressly require that the amylose content must be greater than 45 wt%. Further, such limitation is not recited in any of the claims in Altieri's patent (US 5153037), Applicants' argument to the contrary notwithstanding. Finally, if less than 45 wt% amylose is the point of novelty, the Examiner respectfully reminds Applicants that this limitation is absent from the claims of the instant invention.

With respect to Applicants' argument "claim 1 also requires a specific intrinsic viscosity which is not taught by Altieri" (Remarks, page 15, first paragraph), the Examiner repeats (see Office action mailed 4/10/2003) that although Alteri is silent about the intrinsic viscosity of the starch in DMSO, however, since Altieri teaches essentially the same subject matter (expanded destructured or complexed starch) as the instant claimed invention, in the absence of unexpected results, it is believed that a suitable intrinsic viscosity is either anticipated by Altieri, or an obvious optimization to one of ordinary skill in the art, motivated by the desire to be able to form a stable and


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uniform closed cell structure by extrusion process. It should be noted that where the claimed and prior art products are shown to be identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a *prima facie* case of either anticipation or obviousness has been established. See MPEP § 2112.01.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S Chang whose telephone number is 571-272-1474. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Victor S Chang  
Examiner  
Art Unit 1771

7/16/2004

  
TERREL MORRIS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700